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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

MOONEYHAM, JANICE A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,704

Applicant(s)

BLAU, JOSEPH D.

Examiner

Jan Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on March 26, 2001. Claims 1-14 are currently pending in this application.

Claim Objections

2. Claims 1-14 are objected to because of the following informalities:

MPEP 608.01(m) states that the claim should begin with a capital letter and end with a period. Periods may not be used elsewhere. Furthermore, the applicant should remove all of the capital letters in the body of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant should remove the pronoun "its" from the claim language.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and

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(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-14 only recite an abstract idea. The recited steps of merely enrolling a new member, verifying the credit card, establishing and maintaining a database with a member profile page, and providing the member the right to use a vacation unit does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea. There is no technology in the body of the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Interval International, Inc. (WO 00/63794) (hereinafter referred to as Interval).

Referring to Claim 1:

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Interval discloses a method of operating a vacation resort right to use (vacation clubs – page 3, lines 8-30, page 17, lines 20-27, page 25, lines 28-29) comprising the steps of: enrolling a new member in the database (Fig. 9 (910)) verifying the new member's credit card and monitoring its status (Figs. 22, Fig. 27-27e); establishing and maintaining a member profile page and record of dues payment (Fig. 27 (2710)), and providing the new member the right to use a vacation unit (Fig. 27 – exercise usage rights).

Interval does not disclose providing the member the right to use the vacation interest unit for the applicable period based upon the length of the member's membership. However, Interval does disclose a point system (page 3, lines 15-30). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into Interval the ability to provide the member the right to use the vacation interest based on length of membership since the actual ability of a timeshare owner or vacation club owner to use the share requires a generation of resolved usage rights and these rights are defined during the definition operations (page 14, lines 24-31, Fig. 3 (330, 340)).

Referring to Claim 2:

Interval discloses a method whereby the club has an exchange agreement with an organization having similar agreements with other right to use vacation resorts whereby the member can exchange use of a residential unit for use of a comparable available unit (page 3, lines 8-30), comprising:

communicating the information on the member for enabling enrollment in the exchange organization (Fig. 9, Fig. 22);

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notifying the organization the member's eligibility, based on seniority (points) (Fig. 27);
notifying the organization whenever the member is no longer eligible. (Fig. 27-27e).

Referring to Claims 3-9:

Interval discloses a method for making payments (Fig. 27-27e) and commissions (Fig. 22). Interval does not disclose, from a portion of the member's enrollment fee and periodic charges to the club, making payments to fund the cost of the facilities, making a commission payment to the sales group or party who attracted the member or to the sales agent.

However, the it is old and well known to make commission payments to sales agents and various parties involved in the exchange process. It is also old and well known to set money aside for different purposes, which would include payments to fund the cost of the facilities.

Therefore, it would have been obvious to one of ordinary skill in the art to incorporate into the disclosure of Interval the well known teachings of providing a commission to the sales agents or making payments to fund the cost of the facilities since this is an established business practice.

Referring to Claim 10-11 and 13:

The Examiner takes Official Notice that enrolling members by e-mail, sending notifications by e-mail and requiring members to log on and have a password are old and well known.

Referring to Claim 12:

Interval does not disclose a method wherein the computer tracks the member's membership and assigns rights benefits which increase with time. However, Interval does disclose a points system (page 3, lines 8-30)

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Referring to Claim 14:

Interval discloses a computer based software method for managing properties with updates (Figs. 1-27e). Interval does not disclose an individual web page for exclusive access by the member. However, the Examiner takes Official Notice that individual web pages for exclusive access by members is old and well known.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shell et al discloses a server system which integrates the collection of payment, transfer of the product, calculation and payment or commissions.

Woods, Robert H., discloses important issues which have arisen from the timeshare industry.

De Rafael et al discloses a novel time share exchange which includes a database and automated process that trades, sells, and exchanges properties.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM


DEANT. NGUYEN
PRIMARY EXAMINER